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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,045	05/01/2001	Philip Ted Kortum	8285/431	5221

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EXAMINER
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BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3639

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/847,045

Applicant(s)

KORTUM, PHILIP TED

Examiner

Igor Borissov

Art Unit

3639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-16 and 18-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Amendment received on 3/21/2005 is acknowledged and entered. Claims 1, 8 and 16 have been amended. Claims 1, 3-8, 10-16 and 18-21 are currently pending in the application.

#### ***Claim Rejections - 35 USC § 112***

Claim Rejections under 35 USC § 112 have been withdrawn due to the applicant's amendment.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 5-7, 8, 12-15, 16 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over the "SBC global network DSL: Customer Self Install" (Document) in view of Klees (US 5,283,661).**

The Document, which appears to be published on August, 2000, teaches customer self installation DSL kit and method of installing thereof, comprising:

#### **Independent Claims.**

As per **claim 1**,

- a digital subscriber line modem (page 4; last §);
- at least one digital subscriber line filter (page 1; 3<sup>rd</sup> §);
- a computer-readable medium containing a computer-readable software code (page 9; 2<sup>nd</sup> §).

Furthermore, Document teaches a consumer computer manufacturer's Owner's Guide and computer's Operating System on installation media (CD or diskettes) (page 9; 2<sup>nd</sup> §).

However, Document does not specifically teach that said instruction manual (Owner's Guide) is included in the kit.

Klees teaches an apparatus for assisting in the installation of a facsimile machine, wherein the indication is provided that currently, most facsimile equipment come with a manual that has instructions for installation and setup of the machine (C. 1, L. 14-15).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Document to include that said instruction manual is included in the kit, as disclosed in Klees, because it would advantageously allow to provide the customer with necessary diagram and descriptions of the successive installation steps, thereby simplify the installation process for the customer.

Furthermore, Document teaches:

As per **claim 8**,

- a network card (page 4; last §);
- a digital subscriber line modem (page 4; last §);
- at least one digital subscriber line filter (page 1; 3<sup>rd</sup> §);
- a computer-readable medium containing a computer-readable connection software code (page 9; 2<sup>nd</sup> §).

Furthermore, Document teaches a consumer computer manufacturer's Owner's Guide and computer's Operating System on installation media (CD or diskettes) (page 9; 2<sup>nd</sup> §).

However, Document does not specifically teach that said instruction manual (Owner's Guide) is included in the kit.

Klees teaches an apparatus for assisting in the installation of a facsimile machine, wherein the indication is provided that currently, most facsimile equipment come with a manual that has instructions for installation and setup of the machine (C. 1, L. 14-15).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Document to include that said instruction manual is included in the kit, as disclosed in Klees, because it would advantageously allow to provide the customer with necessary diagram and descriptions of the successive installation steps, thereby simplify the installation process for the customer.

As per **claim 16**, Document teaches:

- a network card
- a digital subscriber line modem (page 4; last §);
- at least one digital subscriber line filter (page 1; 3<sup>rd</sup> §);
- a computer-readable medium containing a computer-readable connection software code (page 9; 2<sup>nd</sup> §).

Furthermore, Document teaches a consumer computer manufacturer's Owner's Guide and computer's Operating System on installation media (CD or diskettes) (page 9; 2<sup>nd</sup> §); and instruction regarding internet service provider software (page 3, 2<sup>nd</sup> and 3<sup>rd</sup> §§).

However, Document does not specifically teach that said instruction manual (Owner's Guide) is included in the kit.

Klees teaches an apparatus for assisting in the installation of a facsimile machine, wherein the indication is provided that currently, most facsimile equipment come with a manual that has instructions for installation and setup of the machine (C. 1, L. 14-15).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Document to include that said instruction manual is included in the kit, as disclosed in Klees, because it would advantageously allow to provide the customer with necessary diagram and descriptions of the successive installation steps, thereby simplify the installation process for the customer.

**Dependent Claims.**

As per **claims 5 and 13**, said kit, wherein the instruction manual provides a point of contact telephone number associated with said kid; said kid including the digital subscriber line modem (page 3, 6<sup>th</sup> §; page 5, 6<sup>th</sup> §; page 4; last §).

As per **claims 6 and 14**, said kit, wherein the instruction manual provides a point of contact telephone number associated with said kid; said kid including the digital line filter (page 3, 6<sup>th</sup> §; page 5, 6<sup>th</sup> §; page 1, 3<sup>rd</sup> §).

As per **claims 7, 15 and 20**, said kit, wherein the instruction manual provides a point of contact telephone number associated with said kid; said kid including the description of computer-readable connection software code (page 9; 2<sup>nd</sup> §).

As per **claims 21**, said kit including an instruction manual (See reasoning applied to **claim 1**).

**Dependent claims 3-4, 10-11 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Document in view of Klees and further in view of Official Notice.**

As per **claims 3-4, 10-11 and 18-19**, Document in view of Klees teach all the limitations of **claims 3-4, 10-11 and 18-19**, except a container, which contains said kit and manual.

Official notice is taken that it is well known to provide goods ordered by customers in shipping containers.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Document to include that said contents of the kit are sent to the customer in a container, because it would advantageously protect the contents of the kit from being damaged or lost during shipment.

***Response to Arguments.***

Applicant's arguments filed 3/21/2005 have been fully considered but they are not persuasive.

In response to the applicant's argument that the prior art fails to disclose *the claimed unified installation process*, it is noted that the claimed invention is directed to the apparatus. Specifically, the independent Claims 1, 8 and 16 refer to *a digital subscriber line self installation kit*.

In response to the applicant's argument that the prior art fails to disclose *at most one instruction manual*, it is noted that Klees was applied for this feature. Specifically, Klees teaches an apparatus for assisting in the installation of a facsimile machine, wherein a manual that has instructions for installation and setup of the machine is provided (C. 1, L. 14-15). The motivation to combine the references would be to advantageously simplify the installation process for the customer by providing necessary diagram and descriptions of the successive installation steps.

In response to the applicant's argument that the prior art fails to disclose a *container*, which contains the contents of the kit, the examiner maintains that it is well known to provide goods ordered by customers in shipping containers. The motivation to use the container would be to advantageously protect the contents of the kit from being damaged or lost during shipment.

***Conclusion***

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (571) 272-6801.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Hayes, can be reached at (571) 272-6708.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***  
***Washington D.C. 20231***

or faxed to:

**571-273-8300**

[Official communications; including After Final  
communications labeled "Box AF"]

Igor Borissov  
Patent Examiner  
Art Unit 3639

A handwritten signature in black ink, appearing to be 'Igor Borissov', written over a horizontal line.

IB

7/07/2005